

REMARKS

These remarks are directed to the office action mailed April 17, 2008, setting a three month shortened statutory period for response set to expire on July 17, 2008. The office action issued by the Examiner and the citation referred to in the office action have been carefully considered.

Prompt reconsideration is requested in view of the above claim amendments and the following remarks. Claim 1 is currently pending, with claim 2 cancelled.

Claim Rejections - 35 USC §112

Claims 1 and 2 have been rejected under 35 USC §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter. Claim 1 has been amended to clarify the claimed subject matter. Claim 2 has been cancelled and incorporated into claim 1. Applicant submits that Applicant's specification does not limit the number of damping members to the number of elastic members or that the placement of the damping members must be adjacent to the elastic members. In paragraph [0019], Applicant teaches at least three high damping members which are arranged at equal intervals, but does not state that the number of damping members must equal the number of elastic members. Applicant submits that claim 1 is now patentable under 35 USC §112.

Claim Rejections - 35 USC §103

Claim 1 has been rejected under 35 USC §103(a) as being unpatentable over Hirose et al. (U.S. Patent No. 5,455,497) in view of Japanese Application 02302899 to Bando Chemical.

Claim 1 has been rejected over an improper combination of references by the Examiner. With the Supreme Court's recent decision in *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007), *KSR* provides guidance with respect to the combination of references used to reject a patent application on the ground of obviousness. According to *KSR*: "Although

common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, **it can be important to identify a reason** that would have **prompted** a person of ordinary skill in the relevant field **to combine the elements** in the way the claimed new invention does.” *KSR* at 1741 (emphasis added).

More importantly, “a patent composed of several elements **is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.**” *Id.* (emphasis added).

In *KSR*, the Supreme Court addressed such logic in obviousness-type rejections. Importantly, *KSR* specifically forbids obviousness rejections simply because each element was independently known in the prior art. The art cited against the instant application falls into this rubric because they are nothing more than a string of unrelated references showing each of the claimed elements with tenuous logic to support their combination.

Hirose discloses a legged mobile robot and system for controlling the robot. Bando discloses a short-fiber containing a rubber member which has anisotropic properties. These cited prior art references are directed to unrelated fields. The combination of these references together makes sense **only** when viewed in the context of the specification and claims. There is no compelling reason why a person of ordinary skill would have combined these references.

Furthermore, claim 1 has been amended to include “at least three high damping members.” None of the cited references teaches at least three damping members to inhibit vibration that affects the control of a walking robot.

Applicant submits that none of the cited teach or suggest all of the elements and limitations of claim 1. Therefore claim 1 is patentable under 35 USC §103. The Examiner is respectfully requested to reconsider and withdraw the Examiner’s rejection.

Conclusion

It is respectfully submitted that all of the Examiner's objections have been successfully traversed and that the application is now in order for allowance. Accordingly, reconsideration of the application and allowance thereof is courteously solicited.

The Director is authorized to charge any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to **Deposit Account Number 50-2638**. Please ensure that Attorney Docket Number 075536-010100 is referred to when charging any payments or credits for this case.

Respectfully submitted,



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